

REMARKS

Claim 1 stands rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Applicant's Admitted Prior Art ("*APA*"). This rejection is respectfully traversed.

Applicants respectfully submit that the Office Action has not established that the *APA* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that independent claim 1 recites "the main body of the image forming apparatus comprises a plurality of openable covers on a front side wall thereof, and at least a part of said transport path is exposed by opening at least one of the plurality of openable covers." The *APA* only discloses features of "conventional apparatuses include a paper transport path on a lateral side of the apparatus, and therefore the paper path provided along the side surface of the apparatus must be opened to remove a sheet stuck in the path upon a paper jam," as stated in the specification at page 4, lines 15-18.

The Office Action also asserts that the tray of the *APA* is movable in two directions. However, the Office Action does not consider the tray of the *APA* only moves in or out, but does not move in, out, left, and right like that of the present invention.

Claims 1-5, 11 and 18 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by *Ohashi*. This rejection is respectfully traversed.

Applicants respectfully submit that the Office Action has not established that *Ohashi* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that independent claim 1 recites "the main body of the image forming apparatus comprises a plurality of openable covers on a front side wall thereof, and at least a part of said transport path is exposed by opening at

least one of the plurality of openable covers.” At least these features are not disclosed or taught by *Ohashi*.

The Office Action asserts that *Ohashi* discloses features of the cover similar to that shown by part 111 in Figs. 25 and 26, Applicants respectfully disagree. Part 111 is actually a manual paper feed portion for inserting paper into the imaging apparatus and not a cover. Further, part 111 is not located “on a front side wall thereof” of the main body of the image forming apparatus as recited in claim 1. Because *Ohashi* does not disclose the cover on a front side wall, it cannot anticipate the invention recited in claim 1.

The Abstract of *Ohashi* also discloses an imaging apparatus that provides “paper sheets from the direction of copying by a user doing a copy work from the back, that is paper discharge side by drawing out an outer frame so as to simultaneously draw out an outer frame tray and an inner frame tray, or drawing out only an inner frame tray against the device main body.” The Office Action suggests that a singular sheet tray 1050 moves in two directions orthogonal to each other. Contrary to this assertion, *Ohashi* discloses two separate trays: an outer tray 1061 and inner tray 1062 that move orthogonally to each other. See Fig. 3 of *Ohashi*. *Ohashi* actually teaches away from the present invention by disclosing two trays. Because *Ohashi* does not disclose the singular tray feature, it cannot anticipate the invention recited in claims 1 and 11.

Applicants respectfully submit that the Office Action has not established that *Ohashi* anticipates each and every feature of Applicants’ claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that independent claim 11 recites “the direction in which the sheet tray is pulled out coincides with the direction in which said recording sheets are fed, and the sheet tray is movable in any of two directions

substantially orthogonal to each other.” At least these features are not disclosed or taught by *Ohashi*.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Ohashi* does not teach or suggest each feature of independent claims 1 and 11.

Additionally, Applicants respectfully submit that dependent claims 2-5 are also allowable insofar as they recite the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

Claims 6 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ohashi* in view of *Ishihara*. This rejection is respectfully traversed.

The Office bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. § 2142. If the Office fails to set forth a *prima facie* case of obviousness, Applicant is under "no obligation to submit evidence of nonobviousness," such as unexpected results or commercial success. *Id.* In other words, if the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness as to a given claim, then that claim is not obvious without any evidence of nonobviousness by the Applicant.

In order to establish a *prima facie* case of obviousness, the Office must satisfy three requirements. M.P.E.P. § 2142. First, "the prior art reference, or references when combined, must teach or suggest *all* the claim limitations." *Id.* (emphasis added). Second, the Office must show that there is "some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." *Id.* Finally, "there must be a reasonable expectation of success."

Id.

In the present case, neither *Ohashi* nor *Ishihara*, either alone or in combination teaches or suggests at least the feature of "the main body of the image forming apparatus comprises a plurality of openable covers on a front side wall thereof, and at least a part of said transport path is exposed by opening at least one of the plurality of openable covers," as recited in claim 1, and the feature of "[a]n image forming apparatus . . . wherein . . . the sheet tray is movable in any of two directions substantially orthogonal to each other," as recited in claim 11, from which claims 6 and 12 depend, respectively.

With respect to claim 6, *Ishihara* does not make up for the deficiencies of *Ohashi*. That is, *Ishihara* does not teach or suggest an image forming apparatus with a plurality of openable covers on a front side wall as recited in claim 1. Thus, the Office Action has not established a *prima facie* case of obviousness at least because neither *Ohashi* nor *Ishihara*, whether alone or in combination, teach or suggest all the recited features of independent claim 1 from which claim 6 depends.

With respect to claim 12, *Ishihara* does not make up for the deficiencies of *Ohashi*. That is, *Ishihara* does not teach or suggest "[a]n image forming apparatus . . . wherein . . . the sheet tray is movable in any of two directions substantially orthogonal to each other," as recited in independent claim 11. Thus, the Office Action has not established a *prima facie* case of obviousness at least because neither *Ohashi* nor *Ishihara*, whether alone or in combination, teach or suggest all the recited features of independent claim 11, from which claim 12 depends.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicants respectfully assert that the third prong of *prima facie* obviousness has not been met. Because the Office Action fails to meet at least one of the three requirements for establishing a *prima facie* case of obviousness, Applicants respectfully request that the rejection of claims 6 and 12 under 35 U.S.C. § 103(a) be withdrawn.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as allegedly being -unpatentable over *Ohashi* in view of *Ishio*. This rejection is respectfully traversed.

Applicants respectfully submit neither *Ohashi* nor *Ishio*, either alone or in combination teaches or suggests at least the features of “the main body of the image forming apparatus comprises a plurality of openable covers on a front side wall thereof, and at least a part of said transport path is exposed by opening at least one of the plurality of openable covers,” as recited in claim 1, from which claim 10 depends. Thus, the Office Action fails to establish a *prima facie* case of obviousness as to claim 10.

Ishio does not make up for deficiencies previously demonstrated in *Ohashi*. Accordingly, it is respectfully submitted that the rejection is in error. Withdrawal of the rejection under 35 U.S.C. § 103(a) over *Ohashi* in view of *Ishio* is respectfully requested. Claim 10 is also allowable at least because it recites the same combination of features as independent claim 1, as well as the additional features it recites that further distinguish them over the applied art.

For the same reasons above-mentioned, it is respectfully submitted that none of the references of record teach or suggest the features of Applicants pending claims. In view of the above arguments, Applicants respectfully request that the rejection of claim 10 under 35 U.S.C. §103(a) be withdrawn.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request entry of the remarks to place the application in clear condition for allowance or, in the alternative, in better form for appeal.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required,

including any required extension of time fees, or credit any overpayment to Deposit Account

50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR
EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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